



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,083	11/22/2000	Kenneth P. Fishkin	106695.01	5446

7590 03/23/2004
Oliff & Berridge PLC
P O Box 19928
Alexandria, VA 22320

EXAMINER

NGUYEN, LE V

ART UNIT PAPER NUMBER

2174

9

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,083

Applicant(s)

FISHKIN ET AL.

Examiner

Le Nguyen

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 9-13 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 9-13 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to Amendment C, filed 3/3/04.
2. Claims 1, 9-13 and 19-21 are pending in this application; claims 1 and 19-21 are independent claims; claim 19 has been amended; and claims 20-21 have been added. The present Office Action follows a second non-final Office Action due to Examiner's oversight in treating claim 19 and, therefore, making this action Final.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

5. Claims 19, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Randell et al. ("Randell", US 6,415,439 B1).

As per claim 19, Randell teaches a method for inputting information, the method comprising whacking a deformable piece integrally connected to a device having a CPU to provide a morpheme input to the CPU, and triggering a first default action by the CPU in response to whacking the deformable piece (col. 7, lines 21-37; col. 11, lines 24-36; col. 12, lines 1-4; col. 8, lines 25-29).

As per claim 20, Randell teaches a method for inputting information, the method comprising manipulating a deformable piece integrally connected to a hand-held computing device to provide a first electro-physical input to the device, the first morpheme input normally triggering a first default action by the device (col. 7, lines 21-37; col. 11, lines 24-36; col. 12,

Art Unit: 2174

lines 1-4; col. 8, lines 25-29), and asynchronously manipulating the deformable piece to provide a second electro-physical morpheme input to the device, with the second morpheme input converting the normally triggered first default action to a second action (col. 7, lines 21-37; col. 11, lines 24-36; col. 12, lines 1-4; col. 8, lines 25-29).

As per claim 21, Randell teaches a method for inputting information, the method comprising manipulating a deformable piece of pliable/malleable material integrally connected to a hand-held computing device to provide a first electro-physical input to the device without using keystrokes, the first morpheme input normally triggering a first default action by the device (col. 7, lines 21-37; col. 11, lines 24-36; col. 12, lines 1-4; col. 8, lines 25-29), and asynchronously manipulating the deformable piece to provide a second electro-physical morpheme input to the device without using keystrokes, with the second morpheme input converting the normally triggered first default action to a second action (col. 7, lines 21-37; col. 11, lines 24-36; col. 12, lines 1-4; col. 8, lines 25-29).

Claim Rejections - 35 USC § 103

6. Claims 1, 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randell et al. ("Randell", US 6,415,439 B1) in view of Paker et al. ("Paker", US 5,299,125).

As per claim 1, Randell teaches a method for inputting information to a device connected to a deformable piece, the method comprising the steps of manipulating the deformable piece to provide a first electro-physical input to the device, the first morpheme input normally triggering a first default action by the device (col. 7, lines 16-37; col. 11, lines 24-36; col. 12, lines 1-4), and asynchronously manipulating the deformable piece to provide a second electro-physical

Art Unit: 2174

morpheme input to the device, with the second morpheme input converting the normally triggered first default action to a second action by the device, wherein the first morpheme and the second morpheme are speech coefficients (col. 7, lines 16-37; col. 11, lines 24-36; col. 12, lines 1-4). Randell does not explicitly disclose that the first morpheme and the second morpheme form a sentence; however, Paker teaches a method for inputting information wherein a first morpheme input and a second morpheme input are speech coefficients and form a sentence (col. 21, lines 22-36). Therefore, it would have been obvious to an artisan at the time of the invention to include Paker's method for inputting information wherein a first morpheme input and a second morpheme input are speech coefficients and form a sentence to Randell's method for inputting information wherein a first morpheme input and a second morpheme input are speech coefficients in order to provide users with an intelligent system that is able to combine morphemes and cipher to produce a syntactically and pragmatically correct sentence.

As per claims 9-11 and 13, Randell teaches a method for inputting information to a device connected to a deformable piece wherein at least one of the first and second morpheme inputs to the device is based on detected light variations, thermal variations, electromagnetic variations and acoustic variations (col. 7, line 27 *light sensitive receptors/light variations*; col. 8, lines 42-47 *heat source/thermal variations*; col. 9, lines 16-25 *broadcasting signals/electromagnetic variations*; col. 12, lines 2-5 *microphone/acoustic variations*).

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Randell et al. ("Randell", US 6,415,439 B1) in view of Paker et al. ("Paker", US 5,299,125).

As per claim 12, although the modified Randell and Paker teaches a method for inputting information to a device connected to a deformable piece wherein at least one of the first and

Art Unit: 2174

second morpheme inputs to the device is based on detected pressure variations (col. 7, lines 25-28; col. 11, lines 25-26; *pressure receptors for receiving user input*), the modified Randell and Paker does not explicitly disclose a method for inputting information to a device connected to a deformable piece wherein at least one of the first and second morpheme inputs to the device is based on detected vibration variations. Official Notice is given that a method for inputting information to a device connected to a deformable piece wherein at least one of the first and second morpheme inputs to the device is based on detected vibration variations is well known in the art. Therefore, it would have been obvious to an artisan at the time of the invention to include detection of vibration variations to the modified Randell and Paker's detection of pressure variations as an implementation preference.

Response to Arguments

7. Applicant's arguments filed in Amendment C have been fully considered but they are not persuasive.

Applicant argued the following:

(a) There is no motivation to combine Randell and Paker.

(b) Nowhere in Randell is any relationship between the first morpheme and the second morpheme disclosed.

(c) The references, Randell and Paker, are from non-analogous fields of endeavor.

The Examiner disagrees for the following reasons:

Per (a), in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or

Art Unit: 2174

modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Randell teaches a method for inputting information to a device connected to a deformable piece, such as a *keyboard*, comprising a first input and a second input wherein a second input modifies the first input (col. 7, lines 16-37; col. 11, lines 24-36; col. 12, lines 1-4). However, Randell's input via keyboard does not explicitly disclose them to be in the form of speech coefficients. The teaching extracted from Parker is for the input, specifically a first input and a second input being speech coefficients.

Per (b), Randell teaches a method for inputting information, the method comprising manipulating a deformable piece integrally connected to a hand-held computing device to provide a first electro-physical input to the device, the first morpheme input normally triggering a first default action by the device (col. 7, lines 21-37; col. 11, lines 24-36; col. 12, lines 1-4; col. 8, lines 25-29; *described is a deformable piece such as the controlled device or a mouse input that triggers a first action, e.g. inherently a mouse's "click"/first morpheme input triggers a first action, by definition that of selecting an item*), and asynchronously manipulating the deformable piece to provide a second electro-physical morpheme input to the device, with the second morpheme input converting the normally triggered first default action to a second action (col. 7, lines 21-37; col. 11, lines 24-36; col. 12, lines 1-4; col. 8, lines 25-29; *described is a deformable piece such as the controlled device or a mouse input that triggers a first action, e.g. inherently a mouse's "click"/first morpheme input triggers a first action while a second or "double*

Art Unit: 2174

click"/second morpheme input triggers second action that modifies the first action, by definition that of activating a program or program feature).

Per (c), in response to applicant's argument that Paker is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Paker and Randell teach a method for inputting information to a device connected to a deformable piece. Moreover, Applicant adheres that both Randell and Paker's device is directed to education of people.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2174

Inquires

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Lê whose telephone number is **(703) 305-7601**. The examiner can normally be reached on Monday - Friday from 5:30 am to 2:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax numbers for the organization where this application or proceeding is assigned are as follows:

(703) 872-9306 [Official Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

LVN
Patent Examiner
March 18, 2004

Kristine Kincaid
KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100